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FULWIDER PATTON LEE & UTECHT, LLP
HOWARD HUGHES CENTER
6060 CENTER DRIVE
TENTH FLOOR
LOS ANGELES, CA 90045

EXAMINER

THOMPSON, KATHRYN L

ART UNIT PAPER NUMBER

3763

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,914

Applicant(s)

WILSON, W. STAN

Examiner

Kathryn L Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jang (US 5,462,530) in view of Hughes (US 268,407). Jang discloses all of the claimed limitations as discussed in Paper No. 3, except providing a retaining element for retaining the tracking guide wire and the integrated guide wire in a spaced apart relationship proximal to the elongated catheter and maintaining the position of the tracking guide wire relative to the integrated guide wire with the retaining element. Hughes discloses providing a retaining element for retaining the tracking guide wire and the integrated guide wire in a spaced apart relationship proximal to the elongated catheter and maintaining the position of the tracking guide wire relative to the integrated guide wire with the retaining element (Figures 1 and 3). It would have been obvious to one with ordinary skill in the art to use the teachings of Hughes to modify the invention of Jang to create a catheter assembly with a retaining element that keeps the two wires in a spaced apart relationship proximal to the elongated catheter in order to hold and prevent the guide wires from slipping.

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Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jang (US 5,462,530) in view of Martin (US 5,366,444). Jang discloses all of the claimed limitations, as discussed in Paper No. 3, except providing a retaining element for retaining the tracking guide wire and the integrated guide wire in a spaced apart relationship proximal to the elongated catheter and maintaining the position of the tracking guide wire relative to the integrated guide wire with the retaining element. Martin discloses providing a retaining element for retaining the tracking guide wire and the integrated guide wire in a spaced apart relationship proximal to the elongated catheter and maintaining the position of the tracking guide wire relative to the integrated guide wire with the retaining element (Figures 1, 2, and 3). It would have been obvious to one with ordinary skill in the art to use the teachings of Martin to modify the invention of Jang to create a catheter assembly with a retaining element that keeps the two wires in a spaced apart relationship proximal to the elongated catheter in order to hold and prevent the guide wires from slipping.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jang (US 5,462,530) in view of Lahay (US 3,696,920). Jang discloses all of the claimed limitations, as discussed in Paper No. 3, except providing a retaining element for retaining the tracking guide wire and the integrated guide wire in a spaced apart relationship proximal to the elongated catheter and maintaining the position of the tracking guide wire relative to the integrated guide wire with the retaining element. Lahay discloses providing a retaining element for retaining the tracking guide wire and the integrated guide wire in a spaced apart relationship proximal to the elongated

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catheter and maintaining the position of the tracking guide wire relative to the integrated guide wire with the retaining element (Figures 1, 2, and 7). It would have been obvious to one with ordinary skill in the art to use the teachings of Lahay to modify the invention of Jang to create a catheter assembly with a retaining element that keeps the two wires in a spaced apart relationship proximal to the elongated catheter in order to hold and prevent the guide wires from slipping.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jang (US 5,462,530) in view of Byrnes et al (US 6,405,414). Jang discloses all of the claimed limitations, as discussed in Paper No. 3, except providing a retaining element for retaining the tracking guide wire and the integrated guide wire in a spaced apart relationship proximal to the elongated catheter and maintaining the position of the tracking guide wire relative to the integrated guide wire with the retaining element. Byrnes et al discloses providing a retaining element for retaining the tracking guide wire and the integrated guide wire in a spaced apart relationship proximal to the elongated catheter and maintaining the position of the tracking guide wire relative to the integrated guide wire with the retaining element (Figures 1, 2, 7, and 8). It would have been obvious to one with ordinary skill in the art to use the teachings of Byrnes et al to modify the invention of Jang to create a catheter assembly with a retaining element that keeps the two wires in a spaced apart relationship proximal to the elongated catheter in order to hold and prevent the guide wires from slipping.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jang (US 5,462,530) in view of EP 0 587 984 A1. Jang discloses all of the claimed limitations, as

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discussed in Paper No. 3, except providing a retaining element for retaining the tracking guide wire and the integrated guide wire in a spaced apart relationship proximal to the elongated catheter and maintaining the position of the tracking guide wire relative to the integrated guide wire with the retaining element. EP 0 587 984 A1 discloses providing a retaining element for retaining the tracking guide wire and the integrated guide wire in a spaced apart relationship proximal to the elongated catheter and maintaining the position of the tracking guide wire relative to the integrated guide wire with the retaining element (Figures 8 and 8A). It would have been obvious to one with ordinary skill in the art to use the teachings of EP 0 587 984 A1 to modify the invention of Jang to create a catheter assembly with a retaining element that keeps the two wires in a spaced apart relationship proximal to the elongated catheter in order to hold and prevent the guide wires from slipping.

Response to Arguments

Applicant's arguments filed on October 17, 2003, have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

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Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Examiner respectfully disagrees with Applicant's opinion that there is no motivation for any of the 103 rejections in the last Office Action of April 8, 2003. Examiner contends that Hughes (Figure 3), Martin (Figure 2), Lahay (Figure 1), Byrnes (Figure 2) and the European patent (Figure 8A) all disclose a retaining element as claimed by the instant application. Structurally, the retaining elements of the aforementioned inventors are identical to the Applicant's retaining element as claimed. Furthermore, in Claim 10, Applicant is merely reciting the function of his retaining element. As long as the retaining element of Hughes, Martin, Lahay, Byrnes, and the European patent is capable of doing the same thing as the retaining element of the instant application, then the prior art references do indeed read on the instant application, as stated in the proper 103 rejections. Examiner also believes that it is clearly disclosed in all of the prior art references that the function of the retaining element is to hold the guidewires/tubes apart from one another. Thus, Examiner maintains her stance that it would have been obvious to one with ordinary skill in the art to take the retaining elements of any one of the prior art references and use it to hold the two guidewires apart from one another, since that is precisely what is disclosed as a teaching, motivation, and/or suggestion of the prior art.

In response to applicant's argument that a surgical tourniquet and a method for positioning a catheter assembly is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re*

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Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the prior art reference is in the field of applicant's endeavor (i.e. medical/surgical equipment).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn L Thompson whose telephone number is 703-305-3286. The examiner can normally be reached on 8:30 AM - 6:00 PM: 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

KLT

KLT

Buhler